

### **REMARKS / ARGUMENTS**

Please note that the amendments to the amendments provided above are offered to further clarify the scope of the independent claims, 1, 32 and 48, as agreed to in an Examiner Interview conducted on February 26, 2004 between the Examiner of Record, Mr. Shawn M. Becker, and the Attorney for the Applicants, Mr. Mark A. Watson. *No new matter has been introduced as a result of the above-listed amendments to the claims, and no new search is required.*

This application is believed to be in condition for allowance because the claims, as amended, are non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. In view of the following reasonings for allowance, the Applicant hereby respectfully requests further examination and reconsideration of the subject patent application.

#### **1.0 Rejections under 35 U.S.C. §103(a):**

In the Office Action of February 9, 2004, claims 48-53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Novell GroupWise 5.5 (as supported by "GroupWise User's Guide for Windows 95/98/NT," (hereinafter "**GroupWise**"), and Novell articles entitled "GroupWise 5.x & 6.x" and "MAPI") and U.S. Patent No. 6,323,853 to Hedloy (hereinafter "**Hedloy**"). In addition, claims 1-3, 5-17, 21-22, 24-36, 38-43 and 45-47 were rejected under 35 U.S.C. §103(a) over **GroupWise**, **Hedloy**, U.S. Patent No. 6,151,624 to Teare, et al. (hereinafter "**Teare**"), and U.S. Patent No. 6,208,399 to Atlas, et al. (hereinafter "**Atlas**").

#### **1.1 Rejection of Claims 48-53:**

As noted above, in the Office Action of February 9, 2004, claims 48-53 were rejected under 35 U.S.C. §103(a) as being unpatentable over **GroupWise** in view of **Hedloy**. However, in an Examiner Interview conducted February 26, 2004 between the

Examiner of record, Mr. Shawn M. Becker, and the Attorney for Applicants, Mr. Mark A. Watson, an agreement was reached as to an amendment to the independent claims which would serve to further clarify the scope of those claims and overcome the rejections under 35 U.S.C. §103(a) in view of the proposed **GroupWise / Hedloy** combination.

In particular, as discussed during the Examiner Interview of February 26, 2004, one advantage of the Applicants claimed invention over the cited art is that the claimed invention provides the capability to completely scan the contents of one or more files existing in a store of documents, i.e., the "data store" and to automatically any extract contact information contained within those contents. In addition, the claimed invention provides the capability to extract such information from document types, including word processor files, spreadsheet files, and presentation files, that are not typically examined by conventional applications for the purpose of automatically extracting contact information. However, the Examiner did not feel that these novel limitations were clearly contained within a broad interpretation of the claimed invention in view of the existing claim language. Consequently, the independent claims have been amended to more clearly recite the agreed upon limitations.

Specifically, as discussed during the Examiner interview, the ability to automatically scan, analyze, or otherwise parse the full contents of particular documents in a data store including word processor files, spreadsheet files, and presentation files, for the purpose of automatically identifying and extracting contact information contained within the contents of such documents, is neither supported by, nor rendered obvious in view of, either the **GroupWise** or **Hedloy** references, or of any combination thereof.

For Example, the Office Action of February 9, 2004 suggested that **Hedloy** disclosed an "address handling method" that includes word processor and spreadsheet files which described "how new contact information may be entered into word processor and spreadsheet files." The Office Action then equated this capability to the system and method for extracting contact information from the files in a data store, as described and claimed by the Applicant. However, in contrast to the position advanced by the Office

Action, and as explained by Attorney for the Applicants during the Examiner Interview of February 26, 2004, **Hedloy** instead describes what appears to be, in at least one embodiment, a type of "macro" or "plug-in." This "macro" or "plug-in" apparently operates with existing applications such as word processor or spreadsheet programs to allow a user to manually select particular typed, or partially typed, information for use in an auto-complete type operation, or for use in data entry type operations.

In particular, as described by **Hedloy**, after a user types a particular name, or other specific piece of information, into an open file in existing word processor or spreadsheet type application, and then manually selects a "button" (typically added to the menu bar of the application using the **Hedloy** "macro" or "plug-in") that name or information is read by **Hedloy** and then used in an attempt to locate a corresponding entry in some database for use in an auto-complete type operation. In other words, based on a limited manual user input, followed by manual user selection of a "button," **Hedloy** then attempts to find matching contact information in a database, which, if present, is then automatically entered into the word processor or spreadsheet file at the point of the limited manual user input (see Col. 3, lines 36-63 of the **Hedloy** reference). Clearly, **Hedloy** requires manual user intervention, and fails completely to disclose scanning the entire contents of particular documents for the purpose of locating and **extracting** contact information. However, as noted above, the Examiner felt that a broad interpretation of the existing claim language did not clearly present this limitation.

Therefore, independent claim 48 has been amended to more clearly recite the intended limitations of the claimed invention, thereby further clarifying the automatic scanning and contact information extraction capabilities of the Applicants claimed invention. This amendment is believed to be fully consistent with limitations agreed to during the Examiner Interview of February 26, 2004. In particular, independent claim 48 now recites the following novel claim language:

"A method for automatically generating a dynamic list of entries containing contact information comprising:

***fully scanning the entire contents of at least one of a plurality of file types***  
in a data store containing electronic files including at least one of word processor files,  
spreadsheet files, and presentation files;

***extracting any contact information contained within any of the scanned  
files;*** and

populating the list with the information extracted from the scanned files.”

(emphasis added)

Therefore, in view of the preceding discussion, the Applicants respectfully suggest that claim 48, as amended, now includes the limitations agreed to with the Examiner as overcoming the rejections under 35 U.S.C. §103(a) in view of the proposed ***GroupWise / Hedloy*** combination. Consequently, the rejection of independent claim 48, as amended, fails to meet the requirements of M.P.E.P. Section 706.02(j) for supporting a rejection under 35 U.S.C. §103(a). In particular, the proposed ***GroupWise / Hedloy*** combination fails to teach all of the elements of the claimed invention, thereby failing to present a prima facie showing of obviousness under 35 U.S.C. §103(a). This lack of a prima facie showing of obviousness means that rejected claim 48, and thus dependent claims 49-53 are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 48, as cited above. Thus, the Applicants respectfully request reconsideration of the rejection of claims 48-53 under 35 U.S.C. §103(a), in view of claim 48, as amended.

## **1.2 Rejection of Claims 1-3, 5-17, 21-22, 24-36, 38-43 and 45-47:**

As noted above, in the Office Action of February 9, 2004, claims 1-3, 5-17, 21-22, 24-36, 38-43 and 45-47 were rejected under 35 U.S.C. §103(a) as being unpatentable over ***GroupWise*** in view of ***Hedloy, Teare, and Atlas***. However, as noted above, during the Examiner Interview conducted on February 26, 2004, an agreement was reached as to an amendment to the independent claims which would further clarify the scope of those claims and overcome the rejections under 35 U.S.C. §103(a) in view of the proposed ***GroupWise / Hedloy / Teare / Atlas*** combination.

In particular, as discussed during the Examiner Interview of February 26, 2004, the ability to automatically scan, analyze, or otherwise parse the full contents of particular documents in a data store including word processor files, spreadsheet files, and presentation files, for the purpose of automatically identifying and extracting contact information contained within the contents of such documents, is neither supported by, nor rendered obvious in view of, any of the **GroupWise**, **Hedloy**, **Teare**, or **Atlas** references, or of any combination thereof.

Independent claim 1, as amended, now includes limitations which further clarify the automatic scanning and contact information extraction capabilities of the Applicants claimed invention, consistent with limitations agreed to during the Examiner Interview of February 26, 2004. In particular, independent claim 1 now recites the following novel claim language:

“An electronic contact resolution method, comprising:  
automatically extracting contact information from any of a plurality of file types included in a data store, said data store including at least one of word processor files, spreadsheet files, and presentation files;  
***wherein extracting the contact information includes automatically examining the complete contents of one or more of the files in the data store and extracting any contact information located within those contents;***  
maintaining a list of at least one contact entry derived from the contact information extracted from the data store;  
automatically computing a weight for each entry in the list;  
tracking contact information associated with the contact entry; and  
automatically resolving contact entries in real time by dynamically providing specific contact entries from the maintained list based on the weight of each entry in the list.” (emphasis added)

Similarly, independent claim 32, as amended, now includes limitations which further clarify the automatic scanning and contact information extraction capabilities of the

Applicants claimed invention, consistent with limitations agreed to during the Examiner Interview of February 26, 2004. In particular, independent claim 32 now recites the following novel claim language:

“A system for automatically generating a dynamic list of entries containing contact information comprising:

a data store comprising electronic files, said electronic files including at least one of word processor files, spreadsheet files, and presentation files;

***a scan module that fully scans the contents of any of the electronic files included in the data store;***

***an extract module that extracts all contact information contained within any of the scanned files;***

a populate module that populates the list with the information extracted from the scanned files; and

a weight module that dynamically computes a weight for each entry in the dynamic list.” (emphasis added)

Therefore, in view of the preceding discussion, the Applicants respectfully suggest that independent claims 1 and 32, as amended, now include the limitations agreed to with the Examiner as overcoming the rejections under 35 U.S.C. §103(a) in view of the proposed ***GroupWise / Hedloy / Teare / Atlas*** combination. Consequently, the rejections of independent claims 1 and 32, as amended, fail to meet the requirements of M.P.E.P. Section 706.02(j) for supporting a rejection under 35 U.S.C. §103(a). In particular, the proposed ***GroupWise / Hedloy / Teare / Atlas*** combination fails to teach all of the elements of the claimed invention, thereby failing to present a prima facie showing of obviousness under 35 U.S.C. §103(a) with respect to independent claims 1 and 32. This lack of a prima facie showing of obviousness means that rejected independent claim 1, and thus dependent claims 2-3, 5-17, 21-22, and 24-31, and rejected independent claim 32, and thus dependent claims 33-36, 38-43 and 45-47 are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1 and 32, as cited above. Thus, the Applicants respectfully request reconsideration of the

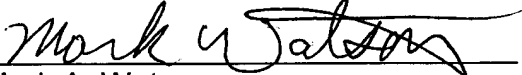
rejection of claims 1-3, 5-17, 21-22, 24-36, 38-43 and 45-47 under 35 U.S.C. §103(a), and objection to claims 18-20 in view of claims 1 and 32, as amended.

**CONCLUSION**

In view of the preceding discussion, and in further view of the Examiner Interview of February 26, 2004, it is respectfully submitted that claims 1-3, 5-36 and 38-53 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-3, 5-17, 21-36 and 38-53, and objection to claims 18-20, and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,

Lyon & Harr  
300 Esplanade Drive, Suite 800  
Oxnard, California 93036  
(805) 278-8855

  
Mark A. Watson  
Registration No. 41,370  
Attorney for Applicants